

REMARKS

Claims 1, 8, 11-13, 21, 24, 26, 27, 35, 38, 40, and 45-54 are currently pending in the subject application and are presently under consideration. Claims 1 and 13 are presently amended. Claims 45-54 are newly added and do not contain new matter. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1, 8, 11-13, 21, 24, 26, 27, 35, 38 and 40 Under 35 U.S.C. §103(a)

Claims 1, 8, 11-13, 21, 24, 26, 27, 35, 38 and 40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Moran (US Patent 6,509,912) in view of Saund (US Patent 6,411,732). Withdrawal of this rejection is requested for at least the following reasons. The cited references, either alone or in combination, fail to teach or suggest all limitations of the subject claims.

[T]he prior art reference (or references when combined) **must teach or suggest all the claim limitations**. See MPEP §706.02(j). The **teaching or suggestion to make the claimed combination** and the reasonable expectation of success **must be found in the prior art and not based on the Applicant's disclosure**. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The claimed subject matter relates to adding information to a file based upon handwritten input from a user. In particular, claim 1 recites in part “wherein the rendering system renders the stored property value in electronic ink format as part of a file preview operation, the file preview discloses a limited information portion of the document or file...” This novel feature is not disclosed in Saund or Moran.

Moran discloses generating domain objects regarding freeform objects. Moran does not disclose rendering the stored property value as part of a file preview operation as is recited in claim 1. The portion cited by the Examiner relates to a gesture (double-tapping) upon an icon that expands information. However, in the cited portion, ‘to expand’ is used in a context of making larger or smaller. Moran discloses *“To expand the information about a domain object, double-tap on the icon. This will result in another layout of the domain object being displayed as an overlay. Sometime it is useful to expand an icon to a somewhat larger version by*

replacing the original icon “ (col. 13, ln 22-24 – emphasis added). Thus, in Moran the icon is a mere condensed version of information (e.g., smaller in size). By contrast, claim 1 recites having a file preview that limits disclosure of information. Thus, Moran teaches an icon that same space by virtue of being smaller in size while claim 1 recites a preview that shows limited information. In addition, Saund is silent regarding a file preview as recited in claim 1.

In particular, claim 13 recites in part “rendering the stored property value in electronic ink format as part of a file preview operation, the file preview operation filters information of the document or file such that a portion less than a whole of the document or less than a whole of the file is part of a file preview...” This novel feature is not disclosed in Saund or Moran.

Moran discloses generating domain objects regarding freeform objects. Moran does not disclose rendering the stored property value as part of a file preview operation as is recited in claim 13 as well as performing any information filtering as disclosed in claim 13. The portion cited by the Examiner relates to a gesture (double-tapping) upon an icon that expands information. However, in the cited portion, ‘to expand’ is used in a context of making larger or smaller. Moran discloses “*To expand the information about a domain object*, double-tap on the icon. *This will result in another layout of the domain object being displayed as an overlay. Sometime it is useful to expand an icon to a somewhat larger version by replacing the original icon* “ (col. 13, ln 22-24 – emphasis added). Thus, in Moran the icon is a mere condensed version of information (e.g., smaller in size). By contrast, claim 1 recites having a file preview that limits disclosure of information. Thus, Moran teaches an icon that same space by virtue of being smaller in size while claim 1 recites a preview that shows limited information. In addition, Saund is silent regarding a file preview as recited in claim 1.

Therefore, for at least the aforementioned reasons, the rejections of claim 1 and 13 (and dependent claims therein) should be removed and the claims placed into a condition of allowance.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP2336USUS].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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